

### REMARKS/ARGUMENTS

The present amendment accompanies a Request For Continued Examination under 37 CFR § 1.114. In the Advisory Action of December 8, 2006, the Examiner withdrew the previous § 112 rejections of claims 79-81 and upheld the § 103 rejection of claims 1-39, 79 and 81 made in the Final Office Action of August 23, 2006. More specifically, claims 1-39 and 79-81 currently stand rejected under 35 U.S.C § 103(a) as being unpatentable over Zietlow et al. (U.S. Patent No. 6,207,216) in view of Igoe (Dictionary of Food Ingredients, 4<sup>th</sup> Edition). By this amendment, claims 1, 5 and 29-32 have been amended and claim 79 has been canceled.

The present invention is directed to a **soft dried** marshmallow. The Applicant notes that the present invention is not simply a recipe, but utilizes food science principals to produce a novel marshmallow having physical and chemical properties that differ from the cited prior art. Importantly, the present invention provides for a marshmallow that is dried and shelf stable, and is also soft in texture, even when immersed in cold fluid. In order to more clearly define the invention, claim 1 has been amended to include the limitation of a glass transition temperature (T<sub>g</sub>) of below 5 °C, and a springback factor of a minimum of 20% and up to 50%. Support for these changes can be found on at least page 8, paragraph 32 and page 14, paragraph 14 of the specification. In addition, claims 2 and 5 have been amended to more distinctly claim the invention and support for these changes can be found on page 8, paragraph 32 of the specification. The remaining claim changes correct typographical errors only. As the prior art does not include each of the limitations set forth in the claims, it is submitted that the present invention is patentably distinct and is in proper form for allowance.

In making the previous § 103 rejection, the Examiner relied on Zietlow et al., which is directed to a dried, **crisp, frangible** marshmallow. In the August 23, 2007 Final Office Action, the Examiner also cited Igoe, which teaches that glycerin can be utilized in a marshmallow. See page 67. Even if Zietlow et al. can be properly combined with Igoe,

the combination does not teach or suggest a marshmallow having the features of the present invention. Regardless, the Applicant notes that there must be proper motivation for the combination of references in a § 103 rejection.

A factor relevant in considering proper motivation to modify prior art is when the prior art teaches away from the claimed invention. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that the Applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). The Applicant respectfully submits that the Zietlow et al. reference clearly teaches away from a **dried soft** marshmallow having a softening agent sufficient to provide a **glass transition temperature of less than 5 °C**. For example, the background of Zietlow et al. discusses dried marshmallow bits for use in cereals, stating that:

“[t]hese dried marshmallow pieces exhibit **desirable crisp, frangible eating qualities**... Generally, dried marshmallow pieces soften but do not dissolve upon exposure to cold milk and rapidly lose their **desirable crisp and frangible eating qualities**. Efforts have thus been made at extending the bowl life of dried marshmallow pieces in cold milk, i.e., **to lessen their propensity to soften in cold milk**.” Emphasis added. See column 1, lines 35-36 and column 2, lines 11-16 of Zietlow et al.

The Zietlow et al. reference clearly does not want to create a soft marshmallow and actually addresses “the problem of softening” by formulating dried marshmallows that dissolve quickly in cold water or milk. The Examiner states that Zietlow et al. teaches moisture loss as a problem in marshmallow compositions. See column 1, lines 21-35 of the Zietlow et al. reference. The Applicant fails to see how this statement provides proper motivation for the combination of Zietlow et al. and Igoe. Moisture loss and softness of a marshmallow are two distinct problems. The present invention is directed to a marshmallow having a moisture content of between 1-10%. Regarding

claims 8, 12 and 14, glycerin is not added to retain moisture, but is added as a softening agent.

Additionally, the Examiner points to the broad statement in Zietlow et al. that the marshmallow of Zietlow et al. can comprise 0.01-25% of additional materials for the improvement of the organoleptic and visual properties of the final food product. See column 4, lines 43-49. The Examiner points to the presence of sodium caseinate and corn syrup (which have moisture retention properties) in Zietlow et al. and states that they function as “softeners.” However, the marshmallow of Zietlow et al. is clearly a crisp marshmallow and not soft at all. In fact, nowhere in Zietlow et al. is there a suggestion to add a softening agent, let alone a softening agent in the amount necessary to provide a glass transition temperature of less than 5 °C and a springback factor of 20-50%. Indeed, one would be hard pressed to argue that the organoleptic or visual properties of the Zietlow et al. confection would be improved by the addition of a softening agent, as the reference teaches the desirability of obtaining crisp, frangible eating qualities. Simply stated, one of ordinary skill in the art would not at all look to add a softening agent to a product desired to be crisp and frangible.

It is true that the prior art teaches utilizing a softening agent in marshmallows. However, the marshmallow in Zietlow et al. has distinctly different properties from a standard marshmallow. There is no motivation provided by the prior art to add a softening agent to the **dried quick dissolving** marshmallow of Zietlow et al. In fact, adding such an agent would actually destroy Zietlow et al. Zietlow et al. discloses a crisp marshmallow that simply would not have a springback factor of 20-50% as required in the amended claims. Many different food additives and ingredients are available, however, that does not mean that there is motivation to combine any or every one of them with the marshmallow of Zietlow et al. As stated by the Federal Circuit: “[o]bviousness cannot be established by combining the teachings of the prior art to product the claimed invention, absent some teaching suggestion or incentive supporting the combination.” *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

Based on the above, it is requested that the prior art rejections be withdrawn, the claims allowed and the application passed to issue. If the Examiner should have any additional concerns regarding the allowance of the application that can be readily addressed, she is cordially invited to contact the undersigned at the number provided below in order to further expedite the prosecution.

Respectfully submitted,



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